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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/458,014	12/10/1999	JACQUES DUMAS	BAYER11-C1	8328
23599	7590	08/24/2005	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			MITCHELL, GREGORY W	
		ART UNIT	PAPER NUMBER	
			1617	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/458,014	Applicant(s) DUMAS ET AL.
	Examiner	Art Unit
	Gregory W. Mitchell	1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 04 May 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-19,21-34,37-55 and 57 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 1-19,21-34,37-55 and 57 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

This Office Action is in response to the RCE filed May 04, 2005. Claims 1-19, 21-34, 37-55 and 57 are pending and are subject to the restriction requirement as set forth herein.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 10, 2005 and May 04, 2005 have been entered.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4 (in part), 5-8, 28-34 (in part), 42-51 (in part), 54, 55 and 57 (in part), drawn to a method of treatment utilizing a pyrazole (i.e. wherein A is pyrazole), classified in class 514, subclass 403.
- II. Claims 1-4 (in part), 9-16, 28-34 (in part), 42-51 (in part), 54, 55 and 57 (in part), drawn to a method of treatment utilizing a 1,2-oxazole (i.e. wherein A is a 1,2-oxazole), classified in class 514, subclass 378.

- III. Claims 1-4 (in part), 22-24, 28-34 (in part), 39, 41, 42-51 (in part), 54, 55 and 57 (in part), drawn to a method of treatment utilizing a 1,3-thiazole (i.e. wherein A is a 1,3-thiazole, including 1,3,4-thiadiazole), classified in class 514, subclass 365.
- IV. Claims 1-4 (in part), 17-19, 21, 25-34 (in part), 42-51 (in part), 54, 55 and 57 (in part), drawn to a method of treatment utilizing a thiophene (i.e. wherein A is a thiophene), classified in class 514, subclass 438.
- V. Claims 1-4 (in part), 28-34 (in part), 37-38, 42-51 (in part), 54, 55 and 57 (in part), drawn to a method of treatment utilizing a 1,3-oxazole (i.e. wherein A is a 1,3-oxazole, including 1,3,4-oxadiazole), classified in class 514, subclass 385.
- VI. Claims 1-4 (in part), 28-34 (in part), 40, 42-51 (in part), 54, 55 and 57 (in part), drawn to a method of treatment utilizing a tetrazole (i.e. wherein A is a tetrazole), classified in class 514, subclass 381.
- VII. Claims 1-4 (in part), 25-34 (in part), 42-51 (in part), 54, 55 and 57 (in part), drawn to a method of treatment utilizing a furan (i.e. wherein A is a furan), classified in class 514, subclass 461.
- VIII. Claims 52 and 53 (each in part), drawn to a 1,2-oxazole compound and composition, classified in class 548, subclass 240.
- IX. Claims 52 and 53 (each in part), drawn to a 1,2-diazole compound and composition, classified in class 548, subclass 356.1.

X. Claims 52 and 53 (each in part), drawn to a thiophene compound and composition, classified in class 549, subclass 29.

XI. Claims 52 and 53 (each in part), drawn to a 1,3-thiazole compound and composition, classified in class 548, subclass 146.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are related to method of treatment utilizing compounds of an entirely different structure.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Because these inventions are distinct for the reasons given above and the search required for any of Groups I-VII is not required for any other of Groups I-VII, since the chemical structures are entirely different, restriction for examination purposes as indicated is proper.

Inventions of Groups VIII-XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are related to method of treatment utilizing compounds of an entirely different structure.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Because these inventions are distinct for the reasons given above and the search required for any of Groups VIII-XI is not required for any other of Groups VIII-XI, since the chemical structures are entirely different, restriction for examination purposes as indicated is proper.

Inventions of Groups VIII-XI are related to Groups I-VII as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case any of the compounds of any other of Groups VIII-XI can be utilized to perform the methods of any of Groups I-VII. Accordingly, the compounds and compositions claimed are not necessary to practice the method claimed.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Because these inventions are distinct for the reasons given above and the search required for any of Groups I-VII is not required for any of Groups VIII-XI, restriction for examination purposes as indicated is proper. It is noted that while the searches may be overlapping, there is no reason to believe that the searches would be co-extensive. It is noted for example, that the search of the compositions will not be sufficient to be a complete search for the

methods because Examiner must also search the art for enablement considerations. Furthermore, the search of the methods would not be sufficient for a complete search of the compositions because the same composition may be known in the art for an entirely different purpose.

This application contains claims directed to the following patentably distinct species of the claimed invention:

- (1) A single disclosed species of disease; and
- (2) A single disclosed species of compound.

If Applicant elects any of Groups I-XI, Applicant is **FURTHER REQUIRED** under 35 U.S.C. 121 to elect a single disclosed species of compound for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. If Applicant elects any of Groups I-VII, Applicant is **STILL FURTHER REQUIRED** under 35 U.S.C. 121 to elect a single disclosed species of disease for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, all claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone call to the attorney is not required where: 1) the restriction requirement is complex, 2) the application is being prosecuted pro se, or 3) the examiner knows from past experience that a telephone election will not be made (MPEP § 812.01). Therefore, since this restriction requirement is considered complex, a call to the attorney for telephone election was not made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.** Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re*

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Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W Mitchell whose telephone number is 571-272-2907. The examiner can normally be reached on M-F, 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gwm



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER